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by Feng et al. 1991 is with withdrawn in view of applicants' amendment.

Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner rejected claim 93 is under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner stated that the specification as originally filed provides no support for an antibody which binds to a polypeptide having the biological activity of a prostate specific membrane antigen with the proviso that the antibody is not the 7E11-C5 monoclonal antibody.

The Examiner stated that any negative limitation or exclusionary proviso must have basis in the original disclosure. See Ex parte Graselli, 231 USPQ 393 (Bd. Pat. App. 1983) aff'd mem., 738 F.2d 453 (Fed. Cir. 1984).

In response, Applicants respectfully traverse the Examiner's objections. The MPEP states that "any negative limitation or exclusionary proviso must have basis in the original disclosure." See MPEP 2173.05(j). See Ex Parte Graselli, 231 USPQ 393 (Bd. Pat. App. 1983) aff'd mem., 738 F.2d 453 (Fed. Cir. 1984). Applicants respectfully contend that there is basis in the original disclosure to support the exclusionary proviso in claim 93.

Applicants respectfully direct the Examiner's attention to Ex parte Parks, 30 USPQ2d 134 (Bd. Pat. App 1993), which cites Ex parte Graselli. A copy of Ex parte Parks is attached hereto as Exhibit A. Applicants respectfully point out that the only caselaw they found upon shepardizing Ex Parte Graselli is Ex

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Parte Parks which is distinguishing. Ex Parte Parks states in pertinent part:

In rejecting a claim under the first paragraph of 35 U.S.C. 112 for lack of adequate descriptive support, it is incumbent upon the examiner to establish that the originally-filed disclosure would not have reasonably conveyed to one having ordinary skill in the art that an appellant had possession of the now claimed subject matter...Adequate description under the first paragraph of 35 U.S.C. 112 does not require literal support for the claimed invention...Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed...We are not unmindful of the decision in Ex parte Graselli. Under the particular facts of that case, it was held that negative limitation introduced new concepts in violation of the description requirement of the first paragraph of 35 U.S.C. 112...In the situation before us, it cannot be said that the originally filed disclosure would not have conveyed to one having ordinary skill in the art that appellants had possession of the concept of conducting the decomposition step generating nitric acid in the absence of a catalyst.
Ex Parte Parks, 30 USPQ2d 1234, 1236 (Bd. Pat. App 1993).

Thus, Ex Parte Parks holds that "it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed." Claim 93 recites "an antibody which binds to a polypeptide having the biological activity of a prostrate specific membrane antigen with the proviso that the antibody is not the 7E11-C5 monoclonal antibody. Thus, as long as the disclosure would have conveyed to one having ordinary skill in the art that applicants had possession of the concept of an antibody which binds to a polypeptide having the biological activity of a prostrate specific membrane antigen with the proviso that the antibody is not the 7E11-C5 monoclonal antibody, then there is adequate description under 35 U.S.C. 112, first paragraph.

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Applicants contend that the 7E11-C5 monoclonal antibody was disclosed in the specification. Page 4, lines 4-5 of the specification teaches that a monoclonal antibody was derived and designated 7E11-C5 and cites Horoszewicz et al (1987) Monoclonal Antibodies to a New Antigenic Marker in Epithelial Prostatic Cells and Serum of Prostatic Cancer Patients, Anticancer Research 7: 927-936 as the reference, a copy of which is disclosed as Exhibit B. Applicants also point out that page 4, lines 23-25 and page 5, lines 1-2 of the specification also discusses 7E11-C5. Thus, Applicants contend that they knew that 7E11-C5 existed before they filed their application.

Applicants contend that they knew of the existence of the 7E11-C5 antibody, as evidenced by them citing it in the specification. Since 7E11-C5 is disclosed in the specification as an antibody that was already known, Applicants contend that the originally-filed disclosure conveys to one skilled in the art that applicants knew the concept of an antibody that encompassed their invention, yet was not 7E11-C5. Thus, Applicants contend that they meet the standard set forth in Ex Parte Parks which would allow them to claim an antibody which is not 7E11-C5.

Applicants contend that these remarks obviate the Examiner's objections and respectfully request that the Examiner reconsider and withdraw the rejection.

Applicants acknowledge the Examiner's statement that claims 94-96, and 98-101 are allowed.

In view of the foregoing remarks, applicants respectfully request that the above grounds of rejection be reconsidered and withdrawn and earnestly solicit allowance of claims 93-96 and 98-101.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned

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attorney invites the Examiner to telephone at the number provided below.

No fee, other than the \$475.00 fee for a three-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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